

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JOSEPH A. HASLWANTER, and  
WILLIAM F. RENCHER

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Appeal No. 2002-0535  
Application No. 09/303,413

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ON BRIEF

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Before ADAMS, GRIMES, and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-25. The examiner indicated (Answer, page 6) that claims 26 and 27, the only remaining pending claims, "would be allowed upon cancellation of all other pending claims."

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A skin barrier lotion comprising: about 5 to 15 percent by weight of a long-chain fatty acid; about 1 to 5 percent by weight of a long-chain fatty alcohol; about 1 to 10 percent by weight of an oil; about 1 to 30 percent by weight of a silicone skin protectant; about 0.5 to about 5 percent by weight of an alkanolamine; about 0.5 to about 5 percent by weight of a humectant; about 0.5 to about 10 percent by weight of an inorganic skin protectant; about 0.5 to 15 weight percent of a preservative; and about 50 to 90 percent by weight water.

The references relied upon by the examiner are:

Suffis et al. (Suffis)	5,378,468	Jan. 3, 1995
Wolf et al. (Wolf)	5,443,855	Aug. 22, 1995

#### GROUND OF REJECTION

Claims 1-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wolf in combination with Suffis.

We reverse.

#### DISCUSSION

According to the examiner (Answer, pages 3-5), Wolf discloses a composition that moisturizes skin comprising all of the elements of appellants' claimed invention but for an inorganic skin protectant, specifically "calamine, kaolin, zinc oxide or zinc carbonate." The examiner relies on Suffis to make up for this deficiency in Wolf. According to the examiner (Answer, page 5), Suffis disclose "a fragranced ointment comprising zinc oxide (see example H, column 19)." Based on this evidence, the examiner concludes (*id.*), "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to substitute zinc oxide as taught by ... [Suffis] for the inorganic pigment of ... [Wolf] with the reasonable expectation of obtaining a skin care composition with suitable pigmentation." The examiner finds that a person of ordinary skill in the art would have been motivated to combine the references "to obtain skin care compositions with suitable pigmentation" and/or "to obtain skin care compositions with the skin protectant properties of zinc oxide." Answer, bridging paragraph, pages 5-6.

In response appellants point out (Brief, page 5), “it is not at all apparent what function is served by zinc oxide in the Suffis et al. compositions. This component is present in only the ointments of Example H and does not appear to be discussed at another point in the disclosure or to be mentioned in the claims.” We agree.

We find no disclosure in Suffis of zinc oxide having pigmentation or skin protectant properties. The examiner’s unsupported assertion is not sufficient to support a prima facie case of obviousness. See In re Lee, 277 F.3d 1338, 1343-1344, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002). See also W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1552, 220 USPQ 303, 312-313 (Fed. Cir. 1983): “To imbue one of ordinary skill in the art with knowledge of the invention.., when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”

Since the examiner failed to provide any evidence supporting her alleged motivation to combine Suffis with Wolf, we are compelled to reverse the rejection of record.

REVERSED

	)	
Donald E. Adams	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
Eric Grimes	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
Lora M. Green	)	
Administrative Patent Judge	)	

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